

Remarks

Telephonic Interview

Applicant thanks Examiner Fidei for granting and conducting a telephonic interview on July 20, 2004, with Applicant's undersigned attorney, Paul John Parins. The Ando (U.S. Pat. No. 3,976,795) and Karevaara (U.S. Pat. No. 4,102,454) references were briefly discussed in relation to the surface discontinuity feature of claim 1. Agreement was not reached. No amendments were discussed.

Amendment

Claims 1-12 are pending in the above-identified patent application. With this Response, the only independent claim, claim 1, is amended. Upon entry of the current amendment, claims 1-12 remain pending.

Claim 1 is amended to clearly recite a container including the unique combination of features, including, 1) a side wall tapering generally from top to bottom "such that the container can nest with one or more other containers" and 2) a surface discontinuity disposed on the tapered side wall, intermediate the rim and bottom of the container, that "helps hold said layer of shrinkwrap in position against said portion of said tapered side wall."

The presently claimed invention is unique because it provides a container with nesting capability (via a tapered side wall structure), while also including a surface discontinuity disposed on the tapered side wall structure, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered side wall. Combining both capabilities in one container is not a trivial exercise and/or objective. There is a bias that surface features on a container sidewall for securing shrinkwrap would interfere with nesting. Conventional wisdom is that such features would make it difficult to insert and/or remove a nested container. Just look at the extreme measures Karevaara, cited in the Office Action and discussed below, takes to achieve nesting and another function (i.e., handles for disposable drinking mugs).

Providing a container that can nest with other containers is advantageous because, e.g., reduced space is required for the containers during, e.g., storage and/or

transportation prior to being filled with items and covered with a lid. Once the containers are filled, they can be wrapped with shrinkwrap to help secure the lid and/or to improve storage. Securing the shrinkwrap to the container can be conventionally done by wrapping the shrinkwrap around the top and bottom edge of the container. However, a downside of conventional containers having a tapered side wall generally from top to bottom is that if shrinkwrap is subsequently torn from the lid to gain access to the container, the shrinkwrap tends to fall from the side of the container. Likewise, any labeling and/or designs attached to the shrinkwrap also fall from the side of the container.

However, Applicant's unique claimed combination overcomes this pitfall by providing a surface discontinuity disposed on a generally tapered side wall of a nestable container, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered side wall. That is, if shrinkwrap is initially wrapped around the top of a container according to Applicant's amended claim 1, and the shrinkwrap is subsequently torn from the top portion of the container, a surface discontinuity according to the present invention helps hold the shrinkwrap in position against the tapered side wall.

This amendment to claim 1 is fully supported by the application as originally filed. Support for amended claim 1 can be found, e.g., at page 5, lines 22 and 23; page 6, lines 16-22 of the specification.

Reconsideration and further examination of the application are respectfully requested in view of the amendment above and remarks below.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 2, 6, and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ando (US 3,976,795).

As mentioned, independent claim 1 is amended to recite the combination of: 1) a side wall tapering generally from top to bottom "such that the container can nest with one or more other containers" and 2) a surface discontinuity disposed on the tapered side wall, intermediate the rim and bottom of the container, that "helps hold said layer of shrinkwrap in position against said portion of said tapered side wall."

Ando does not teach, motivate, or suggest a surface discontinuity disposed on a tapered side wall, intermediate the rim and bottom of a nestable container, that helps hold a layer of shrinkwrap in position against the tapered sidewall.

Ando discloses certain containers for storing and preparing instant cooking foodstuff, where the container and associated cover are completely enclosed with a heat contractible film in a substantially air-tight manner. (See, Ando at col. 1, lines 11-14; col. 2, lines 1-5, 22-24, and 21-40; col. 3, lines 2-8; and Figure 1 (reference character 7)). Thus, the heat contractible film is retained against the container disclosed in the Ando reference because the film completely encloses the container (i.e., bottom and side) and cover.

According to the Office Action, Ando discloses a discontinuity "D" located between the top and bottom of the container. (See, the outstanding Office Action at page 2, numbered paragraph 2).

However, the container surface feature "D" disclosed in the Ando reference does not help hold a layer of shrinkwrap in position against a tapered sidewall of a nestable container, as required in amended claim 1. The surface feature "D" progressively narrows downward. Significantly, the surface feature "D" would not help hold a layer of shrinkwrap in position against a tapered side wall. Thus, the Ando reference does not anticipate claim 1.

Moreover, the Ando reference does not motivate or suggest modifying its disclosure to provide a surface discontinuity disposed on a tapered side wall, intermediate the rim and bottom of a nestable container, that helps hold a layer of shrinkwrap in position against the tapered sidewall. As mentioned above, the heat contractible film disclosed in the Ando reference is retained against the container because the film completely encloses the container (i.e., bottom and side) and cover. According to the Ando reference, this arrangement is perfectly acceptable. That is, there is no indication in the Ando reference that there is difficulty in retaining the contractible film, which is wrapped around the entire container, against the container.

Based on the above discussion, Applicant respectfully submits that claim 1 is patentable over the Ando reference. Claims 2, 6, and 7, each dependent on claim 1, are likewise patentable.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 6, and 7, under 35 U.S.C. 102(b) as being anticipated by Ando be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, and 6-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Karevaara (US 4,102,454).

Independent claim 1 is amended as discussed above.

Also as discussed above, claim 1 is patentable over the Ando reference.

Karevaara fails to cure the deficiencies of Ando.

Karevaara discloses a disposable drinking mug of conical shape and having projections provided on the side of the mug and a handle lying substantially parallel to the side and which may be formed into a grip by bending it. (See, Karevaara at the Abstract and Figures 1-7). Such mugs can be placed in a dispenser from which the mugs may be withdrawn one at a time. (See, Karevaara at col. 1, lines 6-10). According to Karevaara, projections are provided on such drinking mugs to prevent undesirable tilt and friction in a conventional stack of mugs caused by handles on the mugs. (See, Karevaara at col. 1, lines 21-34).

The Karevaara reference does not teach or remotely motivate or suggest to modify the Ando container by providing the Ando container with the projections disclosed in the Karevaara reference. As discussed above, the Ando reference discloses certain containers for storing and preparing instant cooking foodstuff, whereas the Karevaara reference is focused on addressing the challenge imposed by handles on conventional disposable drinking mugs. The Ando reference does not even remotely disclose handles on its containers or a need for such handles. Based on the disclosure of the Ando and Karevaara references, a skilled worker would have had no suggestion or motivation to incorporate the teachings of Karevaara into Ando.

According to the Office Action:

It would have been obvious to one of ordinary skill in the art to modify the relatively smooth sidewall surface of Ando ... Karevaara, in order to facilitate separation when stacking the containers in storage or transportation prior to filling with the food product. (See, the Office Action at page 4) (emphasis added).

However, the Office Action provides no support for making these statements, and no support for such statements is apparent from the Ando and/or Karevaara references. As discussed above, Karevaara was addressing stacking challenges of drinking mugs caused by having handles on their sides. Also as discussed above, Ando does not disclose or remotely suggest or motivate a need for having such handles on the Ando containers. Moreover, the Karevaara reference is completely silent on shrinkwrap and the Ando reference does not disclose any concerns associated with stacking its containers or even disclose that its containers are stacked.

Based on the above discussion, Applicant respectfully submits that claim 1 is patentable over Ando in view of Karevaara. Claims 2 and 6-10, each dependent on claim 1, are likewise patentable.

Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, and 6-10 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Karevaara be withdrawn.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Marino, Jr. et al. (US 5,605,230).

As discussed above, claim 1 is patentable over the prior art above. Claim 3 is dependent on claim 1, thus this rejection will be addressed first with respect to claim 1.

The Marino, Jr. et al. reference fails to cure the deficiencies of the Ando and Karevaara references with respect to claim 1.

The bottle 12 disclosed in the Marino, Jr. et al. reference has a top portion that extends downward into neck portion 18 which widens through shoulder portion 16 and into cylindrical base portion 14, which extends straight down to the bottom of bottle 12 (See, the Marino Jr., et al. reference at col. 2, lines 22-30, and Figure 1).

Marino, Jr. et al. do not teach, motivate or suggest a surface discontinuity disposed on a tapered side wall, intermediate the rim and bottom of a nestable container, that helps hold a layer of shrinkwrap in position against the tapered sidewall. Moreover, the Marion, Jr. et al. reference does not even remotely relate to a container having a side wall tapering generally from top to bottom such that the container can nest with one or

more other containers. Indeed, the Office Action relied on the Marino, Jr. et al. reference merely for disclosing that its plastic sleeve can be torn away from the cap to remove the cap, while the remainder of the sleeve is retained against the Marino, Jr. et al. bottle. (See, the outstanding Office Action at page 5, numbered paragraph 5).

Based on the above discussion, Applicant respectfully submits that claim 1 is patentable over the prior art as applied to claim 2 above, and further in view of Marino, Jr. et al. Claim 3, dependent on claim 1, is likewise patentable.

Accordingly, Applicant respectfully requests that the rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Marino, Jr. et al. be withdrawn.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Gray, Jr. (US 5,489,126).

As discussed above, claim 1 is patentable over the prior art above. Claim 4 is dependent on claim 1, thus this rejection will be addressed first with respect to claim 1.

The Gray reference fails to cure the deficiencies of the Ando, Karevaara, and Marino, Jr. et al references with respect to claim 1.

The Gray, Jr. reference relates to a particular pipe fittings having a label secured thereto with a substantially transparent plastic tube which is shrunk with heat around the pipe fitting and the label. (See, Gray, Jr. at the Abstract).

Gray, Jr. does not teach, motivate or suggest a surface discontinuity disposed on a tapered side wall, intermediate the rim and bottom of a nestable container, that helps hold a layer of shrinkwrap in position against the tapered sidewall. Moreover, the Gray, Jr. reference does not even remotely relate to a container having a side wall tapering generally from top to bottom such that the container can nest with one or more other containers. Indeed, the Office Action relied on the Gray, Jr. reference merely for disclosing the use of adhesive-free labels. (See, the outstanding Office Action at pages 5 and 6, numbered paragraph 6).

Based on the above discussion, Applicant respectfully submits that claim 1 is patentable over the prior art as applied to claim 2 above, and further in view of Gray, Jr. Claim 4, dependent on claim 1, is likewise patentable.

Accordingly, Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Gray, Jr. be withdrawn.

Claims 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Kaufman (US 6,247,612).

As discussed above, claim 1 is patentable over the prior art above. Claim 4 is dependent on claim 1, thus this rejection will be addressed first with respect to claim 1.

The Kaufman reference fails to cure the deficiencies of the Ando, Karevaara, Marino, Jr. et al., and Gray, Jr. references with respect to claim 1.

According to the Office Action, the Kaufman reference discloses an adhesive-free label (See the Office Action at pages 6 and 7, numbered paragraph 7). Applicants note that Kaufman disclose certain bottles having labels attached thereto. (See, Kaufman at col. 6, lines 53-59 and Figures 6 and 8-11).

Kaufman does not teach, motivate or suggest a surface discontinuity disposed on a tapered side wall, intermediate the rim and bottom of a nestable container, that helps hold a layer of shrinkwrap in position against the tapered sidewall. Moreover, the Kaufman reference does not even remotely relate to a container having a side wall tapering generally from top to bottom such that the container can nest with one or more other containers. Indeed, as discussed above, the Office Action relied on the Kaufman reference merely for disclosing certain labels. (See, the outstanding Office Action at pages 6 and 7, numbered paragraph 7).

Based on the above discussion, Applicant respectfully submits that claim 1 is patentable over the prior art as applied to claim 2 above, and further in view of Kaufman. Claims 4 and 5, each dependent on claim 1, are likewise patentable.

Accordingly, Applicant respectfully requests that the rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 2 above, and further in view of Kaufman be withdrawn.

Examiner's Response to Applicant's Arguments Filed March 15, 2004

According to page 7, numbered paragraph 8 of the outstanding Office Action, the Office Action states that Applicants arguments "filed March 15, 2004, have been fully considered but they are not persuasive."

Applicant's arguments filed March 15, 2004, were in response to the Office Action mailed October 10, 2003. In the October 10th Office Action, the following references were cited in rejections: Rashid (US 2001/0006165), Marino, Jr. et al., Gray, Jr., Erlandson (US 4,183,441) and Fillwalk et al. (US 3,235,112).

Applicant hereby submits that none of these references, alone or in combination, teach, motivate, or suggest Applicant's claimed combination of: 1) a side wall tapering generally from top to bottom "such that the container can nest with one or more other containers" and 2) a surface discontinuity disposed on the tapered side wall, intermediate the rim and bottom of the container, that "helps hold said layer of shrinkwrap in position against said portion of said tapered side wall."

Accordingly, if the Office Action intends to maintain the rejections presented in the Office Action mailed October 10, 2003, Applicant respectfully requests the Office Action specifically show how the cited references render Applicant's amended claims, especially amended claim 1 and all of its features, unpatentable in a nonfinal Office Action or withdraw said rejections.

Improper Final Rejection

According to MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims (Emphasis added).

In the outstanding Office Action, new grounds of rejection were presented based on the Ando, Karevaara, and Kaufman references. These rejections were not necessitated by Applicant's amendment of the claims. In Applicant's immediately previous Response, filed March 15, 2004, Applicant amended claims 1, 2, 4, and 5. Claim 1 was amended to include much of the same subject matter that was in claim 2. Claim 2 was

amended accordingly and claims 4 and 5 were amended to correct claim dependency. Such amendments should not have necessitated the new grounds of rejection based on the Ando, Karevaara, and Kaufman references.

Accordingly, Applicant respectfully requests the finality of the outstanding Office Action be withdrawn to provide Applicant with a fair opportunity to respond to the new grounds of rejection.

In view of the above remarks, it is respectfully submitted that the claims and the present application are now in condition for allowance, which allowance is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the undersigned as set out below.

Dated: August 11, 2004

By:

Respectfully Submitted,

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